

REMARKS

Claims 1-59 are presented for further examination. Claims 5, 10-12, 18, 27-28, and 34 have been amended. Claims 37-59 are new.

In the Office Action mailed May 5, 2004, the Examiner objected to Figure 1 because it should be marked with the legend "Prior Art." Applicant is submitting herewith a proposed drawing change to Figure 1 that now includes the legend "Prior Art." Applicant respectfully requests that the proposed drawing change be approved and that substitute formal Figure 1 submitted herewith be entered in the application.

Claims 1-36 were rejected as obvious under 35 U.S.C. § 103(a) over U.S. Patent No. 4,779,346 ("Schafer '346") in view of U.S. Patent No. 4,559,705 ("Hodge et al.") and U.S. Patent No. 4,742,771 ("Heilig").

Applicant respectfully disagrees with the basis for the rejection and requests reconsideration and further examination of the claims.

Discussion of the Present Invention.

The disclosed embodiments of the invention are directed to a transparent measuring device having enhanced visibility lines. Unlike applicant's prior patented device, as shown in Figure 2 of the Schafer '346 reference, the enhanced visibility lines of the present invention include one opaque line that is at least partially overlapped by a wider transparent or translucent line of a contrasting color that is configured to enhance the visibility of the composite line. Ideally, the translucent or transparent line is at least six times wider than the opaque line. More particularly, as shown in Figure 2 of the Schafer '346 reference, from which Figure 1 of the present invention is taken, the first line 24 is of a lesser breadth than the second line 26 where the second line 26 has a width no greater than three times the width of the first line 24. As clearly shown in Figure 2 of the present application, the width of the translucent or transparent line 44 is at least six times wider than the opaque line 40. This feature is described on amended page 5 of the specification, which indicates that the transparent line is "ideally at least six times wider than the opaque lines 40." No new matter has been added with this amendment. Moreover, in another embodiment of the invention, a second opaque line is formed directly on

the first opaque line and having a width no greater than the first opaque line and of a white color to enhance the visibility of the transparent or translucent line when placed against the material to be measured, marked, or cut.

Discussion of the Applied References

Schafer '346 teaches a transparent measuring device with multicolored opaque lines. As shown in Figure 2, Schafer '346 teaches a composite two-color opaque line formed of a first opaque line superimposed upon a second opaque line with the first opaque line having a lesser breadth than the second opaque line such that the second opaque line is visible on each side of the first opaque line (see column 3, lines 10-28). As discussed above, and as shown in Figure 2, Schafer '346 teaches the breadth of the first line to be approximately one-third the breadth of the second line. In addition, there is no teaching or suggestion in Schafer '346 of making one or both of the opaque lines transparent or translucent.

Hodge et al., U.S. Patent No. 4,559, 705, is directed to a flexible sheet of high-static vinyl, acetate, or the like to be used as an overlay for video display devices in which the sheet has indicia "printed as solid symbols or as a uniform tint to allow easier discrimination of the background" (see Abstract). Although Hodge et al. teach that the second indicia may be imprinted "as transparent, white, uniformly tinted characters" (see column 6, lines 32-33), there is absolutely no teaching or suggestion in Hodge et al. of imprinting transparent indicia over solid indicia, or of forming the transparent characters to have a width greater than solid characters, or of enhancing the visibility of the solid or transparent characters by forming a composite line of contrasting colors of these two indicia. Moreover, applying the tinted line over the solid line would defeat the purpose of Hodge et al. because the purpose of the tinted line is to replace the solid line.

Heilig, U.S. Patent No. 4,742,771 is directed to a postal code envelope printer in which a stylus 56 ("defined as a pen," see column 5, lines 7-18) makes a machine-readable mark using "magnetic, phosphorescent, and other suitable underlying machine-readable inks, dyes, etc." Nowhere does Heilig et al. teach or suggest that the machine-readable marks be used on transparent substrates in connection with translucent or transparent lines for viewing material on

which the transparent substrate is placed. In order to be reliably machine-readable, a phosphorescent mark must be solid and not transparent.

Discussion of the Claims

Claim 1 is directed to a tool that comprises a transparent substrate having a plurality of opaque lines formed on at least one surface thereof; and a plurality of transparent lines of a contrasting color to the plurality of opaque lines and formed over the opaque lines to at least partially overlap the respective opaque lines, the plurality of transparent lines formed of a pigment that enhances the visibility of the plurality of transparent lines in a low-light condition. Schafer '346 clearly teaches the use of opaque lines. While Hodge et al. suggest that solid lines printed on a sheet of flexible plastic may be formed of solid or transparent tinted characters, there is no suggestion that such transparent characters should be superimposed on solid indicia to form a composite line. Rather, Hodge et al. teach one or the other, not a combination of the two. While Schafer '346 teaches a composite line formed of opaque lines of different colors, one of ordinary skill would find no motivation to combine Hodge et al. with Schafer. Rather, it appears the motivation for the Examiner's suggestion comes from applicant's claimed invention, which is impermissible hindsight. Even if one were motivated to attempt the combination as suggested by the Examiner, there is no teaching or suggestion in Hodge et al. as to which of the opaque lines in Schafer '346 would be made transparent.

The further addition of the phosphorescent markings of Heilig does not aid the combination of Hodge et al. and Schafer because Heilig teaches the use of phosphorescent marks on a solid envelope in a form that is to be machine-readable. Thus, if one were to combine Heilig with Hodge et al. and Schafer '346, the phosphorescent mark of Heilig would destroy any transparency provided by Hodge et al. Moreover, using a transparent line in Heilig would defeat the purpose of Heilig in that it would not provide a reliable machine-readable mark. In view of the foregoing, applicant respectfully submits that claim 1 as well as dependent claims 2-4 are allowable over the references cited and applied by the Examiner.

Independent claim 5 is directed to a transparent measuring device having enhanced lines formed on a transparent sheet of material with a plurality of first opaque lines

backed by at least one second opaque line of the same width of the plurality of first opaque lines and at least one transparent line formed thereover with a width greater than the width of the first opaque line so as to be visible on at least one side of the opaque line. In addition, the second opaque line is of a color that enhances the visibility of the at least one transparent line. There is absolutely no teaching or suggestion in any of the references cited and applied by the Examiner for this combination of lines as recited in claim 5. Applicant submits that claim 5 and dependent claims 6-9 are allowable for these reasons as well as for the reasons why claim 1 is allowable.

Claim 10 recites a tool similar to claim 1 and includes the transparent substrate having a thickness that is adapted to guide a hand-held rotary cutting tool. Nowhere do Schafer '346, Hodge et al., or Heilig, taken alone or in any combination thereof, teach or suggest a transparent substrate having such a thickness. Applicant respectfully submits that claim 10 and dependent claims 11-19 and 37-39 are allowable for these reasons as well as for the reasons why claim 1 is allowable.

With respect to dependent claims 17-19, there is no teaching or suggestion in Hodge et al. of applying the static cling material to a transparent ruler such that tinted transparent indicia overlap opaque lines. Claims 37-39 are directed to the embodiment wherein a second opaque line is applied over the first opaque line and of a white color to enhance the visibility of the transparent line. Applicant submits these claims are allowable because this feature is not taught or suggested by any of the references.

Independent claim 20 is directed to a tool in which the transparent lines are formed in a transparent flexible substrate that is then applied to the substrate to overlap the opaque lines to form a composite line. Applicant submits that claim 20 and dependent claims 21-24 are allowable for the reasons discussed above with respect to claims 1-19.

Claims 25-36 and 41-49 are directed to a method of forming or making a tool for use in measuring and marking material that has the transparent rigid substrate with at least one opaque line formed thereon and a transparent line formed over the at least one opaque line and having a width greater than the width of the opaque line to at least partially overlap the opaque line, the transparent line formed of a color that is contrasting to the color of the opaque line that reacts to light to provide enhanced visibility of the composite line formed by the transparent line

and the opaque line. Additional embodiments of the method of making include applying a second opaque line over the first opaque line with the width the same as the first opaque line to enhance the visibility of the subsequent transparent line. Applicant submits that these method-of-making claims are allowable for the reasons discussed above with respect to claims 1-24.

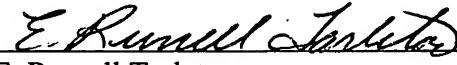
In view of the foregoing, applicant submits that all of the claims in this application are clearly in condition for allowance. In the event the Examiner finds minor informalities that can be resolved by telephone conference, the Examiner is urged to contact applicant's undersigned representative by telephone at (206) 622-4900 in order to expeditiously resolve prosecution of this application. Consequently, early and favorable action allowing these claims and passing this case to issuance is respectfully solicited.

Figure 1 has been amended to include the legend "Prior Art" and 1 sheet of drawings is presented herewith for approval.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,
SEED Intellectual Property Law Group PLLC


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ERT:alb

Enclosure:

Postcard
1 Sheet of Drawings (Figure 1)

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